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EXAMINER

GARTLAND, SCOTT D

ART UNIT	PAPER NUMBER
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3622

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/723,151	Applicant(s) CONNELLY ET AL.	
	Examiner SCOTT D. GARTLAND	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-31,33,35-43 and 45-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-31,33,35-43 and 45-64 is/are rejected.
- 7) ☒ Claim(s) 37 and 55 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. This Final Office Action is in response to the communication filed on March 22, 2010 and April 27, 2010. Claims 3, 7, 32, 34, and 44 have been cancelled, claims 1, 4, 6, 8, 11, 20-21, 25-28, 31, 33, 35-37, 45-46, 54-55, and 62-63 have been amended, and no claims have been added. Therefore, claims 1-2, 4-6, 8-31, 33, 35-43, and 45-64 are pending and presented for examination.

Response to Amendment

2. A summary of the Response to Applicant's Amendments:
 - The Examiner acknowledges receipt of the replacement drawing sheets.
 - The Examiner notes that Applicant's listing of amended claims in the Remarks is incorrect - please see the above listing.
 - The Examiner notes that claim 28 is labeled as "Original" but contains edit markings; therefore the respective editing will be regarded as amendments and entered despite the incorrect labeling, without issuing a Notice of Non-Compliant Amendment. The Examiner further notes, however, that if there are other incorrect labels or markings, the Examiner has not noticed them, and they will not be entered or effective.
 - Applicant's amendment overcomes the objections to claims 7 and 44; therefore, the Examiner withdraws the objections.

- Applicant's amendment does not overcome the objections to claims 37 and 55; therefore the Examiner maintains the objections.
- Applicant's amendment does not overcome the rejections under 35 USC § 112, second paragraph, of claims 45 and 63-64; therefore the Examiner maintains the rejections as below, noting some further explanation or reasoning based on Applicant's amendment.
- Applicant's amendment overcomes the rejection of claims 1-20 under 35 USC § 101; therefore the Examiner withdraws the rejections.
- Applicant's amendment does not overcome the rejections of claims 46-64 under 35 USC § 101; therefore the Examiner maintains the rejections.
- Applicant's amendments do not overcome the prior art rejections under 35 USC §§ 102 and 103; therefore the Examiner maintains the rejections as below.
- Applicant's arguments are not persuasive; please see the Response to Arguments below.

Drawings

3. Replacement drawings were received on April 27, 2010, and are acknowledged and accepted.

Claim Objections

4. **Claims 37 and 55 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a**

previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 37 and 55 recite the same limitations as that recited in parent claims 36 and 54, respectively, except the intended use or expected result of identifying relatively popular search queries. Since the intended use may be granted little or no patentable weight, claims 37 and 55 do not further limit claims 36 and 54, respectively.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 5. Claims 45 and 63-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The claim 45 elements of “receiving” and “selecting” are means (or step) plus function limitations that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The Examiner has searched Applicant's specification for a definition limiting the scope of the means for receiving, and notes that according to

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the specification, the means may be "via an on-line application" (paragraph 007), or via a web page and/or the internet (0036), which indicates that the "means for" may include software or a document (such as a web page), rather than a structural element or component. Furthermore, the means for selecting is described as being the Ad SWF (0082), which is identified as a type of file (0080). Since these elements are not defined as limited to structural components, the apparent limiting scope is outside the realm of a system.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim 63 recites a perceptible, changeable medium; however, the Examiner understands this to include virtually all forms or mediums of communication since Applicant, at specification paragraph 0074, indicates that this may include an audible medium, and paragraph 003 indicates that it also includes computers or billboards which would apparently be perceptible by sight. As such any communication, since it must be perceptible in order to be understood, appears encompassed; therefore the Examiner is uncertain as to the scope, or meets and bounds, of this claim. Based on the amendment, Applicant is reminded that claim 63 is directed to a MEDIUM, and as such, whether the information and queries are displayed does not limit the medium - the medium may still be audible information and queries, as long as those words are, at some time, also displayed; in other words, the display, since the claim is directed to a medium, is merely an expected or intended result and as such may be granted little if any patentable weight.

Claim 64 depends from claim 63 and does not resolve the above issue, and therefore the Examiner is uncertain as to the scope, or meets and bounds, of claim 64 also.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 46-64 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 46 is drawn to a method comprising steps of providing a feed of queries, providing advertising, and initiating display. Since the display is of an advertisement including a scrolling ticker, a machine is required; however, the Examiner notes that the phrasing indicates the display of the advertisement is by the computer, but the initiating may be performed, for example, by a person at or using the computer. Therefore, only the actions of providing and displaying are recited as performed by the computing device, and these actions do not provide a meaningful limit on the scope of the claim. No physical transformation of matter is indicated or recited, either; therefore, since the method does not require a particular machine or the machine does not offer a meaningful limitation on the claim scope, nor does the claim physically transform matter, claim 46 is directed to nonstatutory subject matter.

Claims 47-61 depend from claim 46 and do not resolve this issue, and are therefore also directed to nonstatutory subject matter.

The Examiner suggests, as a remedy, reciting a significant step, such as a filtering, generating, solving, determining, or deciding step, as performed on a

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particular machine such as a computer programmed particularly for that function.

The Examiner notes that of the current claim steps, providing a feed and advertising content as well as initiating display appear to be insignificant extra-solution activity, similar to sending and receiving, that may not impose a meaningful limit on the claim.

Claim 62 is directed to an advertisement. An advertisement is not considered to be one of a process, machine, article of manufacture, or composition of matter; therefore claim 62 is directed to nonstatutory subject matter.

Claim 63 is directed to a perceptible, changeable medium. The Examiner understands this to include virtually all forms or mediums of communication since Applicant, at specification paragraph 0074, indicates that this may include an audible medium, and paragraph 003 indicates that it also includes computers or billboards which would apparently be perceptible by sight. As such any communication, since it must be perceptible in order to be understood, appears encompassed. As a claim drawn to a medium, claim 63 is arguably within one of the statutory classes of a machine or article of manufacture; however, the claim is directed to the abstract idea of communication overall, only limited by filtered search queries, and as such is not directed to a practical application of that abstract idea. Furthermore, even if one could surmise that a search query were a practical application, claim 64 covers all

practical applications of communicating a search query; therefore preempting all practical applications. Therefore claim 63 is directed to nonstatutory subject matter.

Claim 64 depends from claim 63 and does not resolve the above issue, and therefore claim 64 is also directed to nonstatutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 7. Claims 1-2, 4-6, 8-15, 17-18, 20-23, 25-27, 29-31, 33, 36-41, 43, 45, and 62-64 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Speiser et al. (U.S. Patent Application Publication No. 2004/0078214, hereafter Speiser).**

Please note that, as a convenience to applicant, the Examiner has pointed out, by **bolding**, optional or intended use language, and included a note as to the ramifications of such language below.

Claim 1: Speiser discloses a method of providing a display, the method comprising:

receiving, by a computing device, search queries from multiple users (paragraph 0027; citation hereafter by number only), **wherein** each search query in the search queries has associated demographic data (0045, 0047, country, language, etc., Figs. 4A-C);

filtering, by the computing device, the search queries based on one or more filtering criteria (0049-0056) the filtering criteria including demographic criteria (0045, 0047, country, language, etc., Figs. 4A-C) and **wherein** the filtering comprises identifying queries having demographic information matching the demographic criteria (0045, 0047, country, language, etc., Figs. 4A-C); and

initiating, by the computing device, display of the filtered search queries to viewers, the viewers remote from the users (0044, 0085-0086, Figs. 12A and B).

Claim 2: Speiser discloses the method of claim 1, wherein the filtering criteria include words (0056).

Claim 4: Speiser discloses the method of claim 1, wherein the viewers have viewer demographics, the method further comprising selecting demographic criteria to match viewer demographics, the filtering including identifying queries having demographic information matching the viewer demographics, thereby initiating display of filtered search queries relevant to the viewers (0085; 0047).

Claim 5: Speiser discloses the method of claim 1, wherein the filtering criteria include search queries previously entered by users and the filtering includes discarding previously entered search queries (0058, the Examiner understands terms matching the filter words to be discarded when they are prevented from being displayed and the determination moves to consider other terms).

Claim 6: Speiser discloses the method of claim 1, wherein the filtering criteria include a number of times a search query is presented (0047; Fig. 4C, item 94).

Claim 8: Speiser discloses the method of claim 1, wherein initiating the display includes initiating display of filtered search queries to viewers at an event (0085, Figs. 12A and B; the Examiner understands an event to be something that takes place, or an occurrence, such as searching, shopping, or bidding at an auction website).

Claim 9: Speiser discloses the method of claim 6, wherein the filtering criteria include a certain website and a number of times a search query is presented, the filtering including **identifying relatively popular search results** received via the certain website (0047; Fig. 4C, items 94 and 96; and 0040, 0047, where the Site ID identifies the certain website).

Claim 10: Speiser discloses the method of claim 6, wherein the filtering criteria include demographic criteria and a number of times a search query is presented, the filtering including **identifying relatively popular search queries** received from users having demographics matching the demographic criteria (0047; Fig. 4C, items 94 and 96).

Claim 11: Speiser discloses a method of providing a display of information on a web page, the method comprising:

receiving, by a computing device, search queries from multiple users (0027),
wherein each search query in the search queries has associated demographic data (0045, 0047, country, language, etc., Figs. 4A-C);

filtering, by the computing device, the search queries based on filtering criteria (0049-0056) the filtering criteria including demographic criteria and **wherein** the filtering comprises identifying queries having demographic information matching the demographic criteria (0045, 0047, country, language, etc., Figs. 4A-C); and

facilitating, by the computing device, display of said filtered search queries on the web page (0044, 0085-0086, Figs. 12A and B).

Claim 12: Speiser discloses the method of claim 11, wherein the display is an advertisement including display of said filtered search queries (0085-0086, Figs. 12A and B; the Examiner understands that the listings are each advertisements to use that term or go to that related content; the Examiner notes that what data is

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displayed within an advertisement is descriptive material that may be granted little or no patentable weight).

Claim 13: Speiser discloses the method of claim 12, wherein the advertisement is on behalf of an advertiser, the method further comprising receiving filtering criteria from the advertiser (0085-0086, Figs. 12A and B; the Examiner understands that the listings are on behalf of an advertiser since they have listed the item(s) for auction at the site, and that among the filter criteria are categories or specific sellers, such as Phone Cords, Prepaid Phone Cards, the Phones Store, Sharper Image, etc., the items are listed under).

Claim 14: Speiser discloses a method of claim 12, wherein the advertisement is for a product and the filtering criteria include an association between the product and search queries (0085-0086, Figs. 12A and B; the Examiner understands that the listings are for products, and the "Related" Items and Stores to indicate association).

Claim 15: Speiser discloses a method of claim 12, wherein the advertisement is for a product, the search queries have associated demographic information based on the users from which they are received and the filtering criteria include demographic criteria, the demographic criteria matching potential purchasers of the product (0085-0086, Figs. 12A and B, 0040, 0045, 0047, Fig. 4C; demographics indicated by country, language, etc.).

Claim 17: Speiser discloses the method of claim 11, wherein display of filtered search queries includes display of a filtered search query link, activation of which initiates display of search results corresponding to the filtered search query link (0085-0086, Figs. 12A and B).

Claim 18: Speiser discloses the method of claim 17, wherein initiating display of the filtered search queries includes facilitating display of an advertisement and wherein activation of the link further includes display of advertising content (0085-0086, Figs. 12A and B; the Examiner understands the items listed on the left of Fig. 12A, such as the items at Fig. 12B, to be links, and activating the link directs to another list of ads, such as at the items shown in the middle of Fig. 12A).

Claim 20: Speiser discloses the method of claim 12, wherein the advertisement further includes a search toolbar (Fig. 12A, top left corner).

Claim 21: Speiser discloses a method for displaying data based on user input, the method comprising:

receiving, by a computing device, user input from multiple users via an on-line application (0027, 0032);

automatically selecting, by the computing device, received user input for display based on filtering criteria (0056); and

facilitating, by the computing device, display of data based on the selected user input to users (0044, 0085-0086, Figs. 12A and B).

Claim 22: Speiser discloses the method of claim 21, wherein:

the user input is a query entered into a help application (0027; the Examiner understands searching to be a help application);

the selecting includes selecting received user input based on frequency of receipt (0047; Fig. 4C, item 94); and

the facilitating includes initiating display of a frequently received query (0047; Fig. 4C,) and a response to the frequently received query to the users (0085-0086, Figs. 12A and B).

Claim 23: Speiser discloses the method of claim 22, wherein the users are in communication via a network (0005).

Claim 25: Speiser discloses a system comprising:

a first server communicatively coupled to a user interface, the first server selecting received user input **for display** based on first filtering criteria (0030, 0044, 0054, 0056), **wherein** the user input has associated demographic data (0045, 0047, country, language, etc., Figs. 4A-C), wherein the first filtering criteria includes demographic criteria (0045, 0047, country, language, etc., Figs. 4A-C), and **wherein** the selection of received user input is based on a match of the demographic

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information with the demographic criteria (0045, 0047, country, language, etc., 0049-0056, Figs. 4A-C); and

a visual display server initiating display of data based on the selected user input (0044, 0085-0086, Figs. 12A and B).

Claim 26: Speiser discloses the system of claim 25, further comprising:

a second server communicatively coupled to the first server (0030), the second server selecting received user input for display based on second filtering criteria (0040, 0047, 0085-0086, Figs. 12A and B).

Claim 27: Speiser discloses the system of claim 25, wherein the visual display server initiates display of user input via a web page (0085-0086, Figs. 12A and B).

Claim 29: Speiser discloses the system of claim 25, wherein the user input is search queries (0027).

Claim 30: Speiser discloses the system of claim 25, wherein the display of data is display of an advertisement (0085-0086, Figs. 12A and B; the Examiner understands that the listings are each advertisements to use that term or go to that related content).

Claim 31: Speiser discloses a system comprising:

one or more processors (0093-0094) **configured to**:
receive user input from multiple users via a network (0027) **wherein** the user input is one or more search queries and **wherein** the search queries have associated demographic information (0045, 0047, country, language, etc., Figs. 4A-C);
select received user input for display based on one or more filtering criteria (0049-0056), the one or more filtering criteria including demographic criteria (0045, 0047, country, language, etc., Figs. 4A-C), **wherein** the one or more processors are **configured to** identify queries having demographic information matching the demographic criteria (0045, 0047, country, language, etc., 0049-0056, Figs. 4A-C);
and
facilitate display of data based on the selected user input to viewers (0044, 0085-0086, Figs. 12A and B).

Claim 33: Speiser discloses the system of claim 31, wherein the one or more filtering criteria include words (0056).

Claim 36: Speiser discloses the system of claim 31, wherein the one or more filtering criteria include number of times a search query is received (0047; Fig. 4C, item 94).

Claim 37: Speiser discloses the system of claim 36, wherein the one or more filtering criteria **identifies relatively popular search** queries from the number of times a search query is received (0047; Fig. 4C, item 94).

Claim 38: Speiser discloses the system of claim 36, wherein the one or more processors are configured to facilitate display of selected search queries to viewers at an event (0085, Figs. 12A and B; the Examiner understands an event to be something that takes place, or an occurrence, such as searching, shopping, or bidding at an auction website).

Claim 39: Speiser discloses the system of claim 36, wherein the filtering criteria include a certain website and number of times a search query is received, the one or more processors configured to identify relatively popular search results received via the certain website (0047; Fig. 4C, items 94 and 96; and 0040, 0047, where the Site ID identifies the certain website).

Claim 40: Speiser discloses the system of claim 36, wherein the one or more filtering criteria include demographic criteria and a number of times a search query is presented, the one or more processors configured to identify relatively popular search queries received from users having demographics matching the demographic criteria (0047; Fig. 4C, items 94 and 96).

Claim 41: Speiser discloses the system of claim 36, wherein the one or more processors are configured to facilitate display of selected search queries in an advertisement on a web site (0085-0086, Figs. 12A and B; the Examiner understands that the listings are each advertisements to use that term or go to that related content; the Examiner notes that what data is displayed within an advertisement is descriptive material that may be granted little or no patentable weight).

Claim 43: Speiser discloses the system of claim 42, wherein the one or more processors are configured to facilitate display of one or more selected search query links, activation of which initiates display of search results corresponding to the activated filtered search query link (0085-0086, Figs. 12A and B).

Claim 45: Speiser discloses a system comprising:

a computing device comprising:

means for receiving user input from multiple users via a network (0027, 0030, 0093-0094) the user input associated with demographic information (0045, 0047, country, language, etc., Figs. 4A-C);

means for selecting received user input for display based on one or more filtering criteria (0056, 0030, 0093-0094), the one or more filtering criteria including demographic criteria (0045, 0047, country, language, etc., Figs. 4A-C) and **wherein** the selecting comprises identifying user input having demographic information

matching the demographic criteria (0045, 0047, country, language, etc., Figs. 4A-C);
and

means for facilitating display of data based on the selected user input to viewers
(0044, 0030, 0093-0094).

Claim 62: Speiser discloses an advertisement for display on a viewing device,
comprising:

a portion for containing advertising content (0085-0086, Figs. 12A and B; the
Examiner understands that the listings are each advertisements to use that term or
go to that related content); and

a portion for changeably displaying, on the viewing device, search queries that
have been filtered in accordance with predetermined filter criteria (0047; Fig. 4C,
items 94 and 96; 0085-0086, Figs. 12A and B; the Examiner understands that the
listings are each advertisements to use that term or go to that related content).

Claim 63: Speiser discloses a perceptible, changeable medium comprising:

predetermined perceptible information displayed on a computing device, (0085-
0086, Figs. 12A and B); and

perceptible, changeable search queries, displayed on a computing device, that
have been filtered in accordance with filter criteria (0047; Fig. 4C, items 94 and 96;
0085-0086, Figs. 12A and B), wherein the filter criteria is demographic criteria (0045,
0047, country, language, etc., 0049-0056, Figs. 4A-C).

Claim 64: Speiser discloses the medium of claim 63, wherein the perceptible search queries change over time in accordance with predetermined change criteria (0040, 0047, 0056, 0085-0086).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 8. Claims 16, 19, 24, 28, 35, 42, and 46-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speiser.**

Claim 16: Speiser discloses the method of claim 12, wherein the advertisement includes a list of filtered search queries (0085-0086, Figs. 12A and B); however, Speiser does not explicitly disclose that the list is a scrolling list. The Examiner understands that a scrolling advertisement is one of a limited number of predictable options available for forms of advertisements.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to include a scrolling list in the advertisement.

The rationale for combining in this manner is that a scrolling advertisement is one of a limited number of predictable options available for forms of advertisements.

Claim 19: Speiser discloses the method of claim 11, but does not explicitly disclose wherein facilitating display of the filtered search queries includes initiating a Flash movie. Speiser, however, discloses listing the popular search queries (0085-0086, Figs. 12A and B). The Examiner understands that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to initiate a Flash movie via the advertisement.

The rationale for combining in this manner is that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Claim 24: Speiser discloses the method of claim 21, but does not explicitly disclose wherein the selecting includes disregarding input received from a first user where the first user has previously entered the search query or a similar search query. Speiser, however, teaches the number of searches (Fig. 4C, item 94) and that the number of results to popular searches according to category may be provided (0040). The Examiner understands that disregarding multiple inputs from a user is one of a limited number of predictable options available for reflecting popularity of search terms.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to disregard input from a first user where the first user has previously entered the search query or a similar search query.

The rationale for combining in this manner is that disregarding multiple inputs from a user is one of a limited number of predictable options available for reflecting popularity of search terms.

Claim 28: Speiser discloses the system of claim 25, but does not explicitly disclose wherein the visual display server initiates display of user input via a Flash movie. Speiser, however, discloses listing the popular search queries (0085-0086, Figs. 12A and B). The Examiner understands that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to initiate a Flash movie via the advertisement.

The rationale for combining in this manner is that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Claim 35: Speiser discloses the system of claim 32, but does not explicitly disclose wherein the filtering criteria include search queries previously entered by users and the one or more processors are configured to discard previously entered search queries. Speiser, however, teaches the number of searches (Fig. 4C, item

94) and that the number of results to popular searches according to category may be provided (0040). The Examiner understands that disregarding multiple inputs from a user is one of a limited number of predictable options available for reflecting popularity of search terms.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to disregard input from a first user where the first user has previously entered the search query or a similar search query.

The rationale for combining in this manner is that disregarding multiple inputs from a user is one of a limited number of predictable options available for reflecting popularity of search terms.

Claim 42: Speiser discloses the system of claim 41, wherein the advertisement includes a list of selected search queries (0085-0086, Figs. 12A and B); however, Speiser does not explicitly disclose that the list is a scrolling list. The Examiner understands that a scrolling advertisement is one of a limited number of predictable options available for forms of advertisements.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to include a scrolling list in the advertisement.

The rationale for combining in this manner is that a scrolling advertisement is one of a limited number of predictable options available for forms of advertisements.

Claim 46: Speiser discloses a method of providing an advertisement, the method comprising:

providing, by a computing device, a feed of search queries, the search queries received from users (0027);

providing, by the computing device, advertising content (0085-0086, Figs. 12A and B; the Examiner understands that the listings are each advertisements to use that term or go to that related content); and

initiating display of the advertisement, by the computing device, (0044), the advertisement including search queries of the feed and the advertising content (0085-0086, Figs. 12A and B, 0047, Fig. 4C; the Examiner notes that what data is displayed within an advertisement is descriptive material that may be granted little or no patentable weight).

Speiser, however, does not explicitly disclose that the queries are in the form of a scrolling ticker of search queries. Speiser, however, teaches a list of selected search queries (0085-0086, Figs. 12A and B) and the Examiner understands that a scrolling ticker advertisement is one of a limited number of predictable options available for forms of advertisements for displaying search queries.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to include a scrolling ticker in the advertisement.

The rationale for combining in this manner is that a scrolling ticker advertisement is one of a limited number of predictable options available for forms of advertisements for displaying search queries.

Claim 47: Speiser further discloses the method of claim 46, wherein the feed is an XML document (0029).

Claim 48: Speiser discloses the method of claim 46, but does not explicitly disclose wherein the feed is provided in near real time after receiving the search queries. Speiser, however, teaches tracking the date and time of day that a search query is entered (0045, Fig. 4A), and tracking the ending time of an auction to within 2 minutes (Fig. 12 A, upper right). The Examiner understands that the term “near real time” may refer to different periods or time delays depending on one’s perspective or reference; as such, the setting of process timing (or delays) so as to constitute near real time may change, and how close to actual real time one desires to be is limited primarily or only by processing speed and cost offsets. Therefore, the Examiner understands that providing a feed in near real time is both one of a limited number of predictable options available and a design choice.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to provide the feed of queries in near real time.

The rationale for combining in this manner is that providing a feed in near real time is both one of a limited number of predictable options available and a design choice.

Claim 49: Speiser further discloses the method of claim 46, wherein the search queries are filtered in accordance with one or more filtering criteria (0056).

Claim 50: Speiser further discloses the method of claim 49, wherein the filtering criteria include words (0056).

Claim 51: Speiser further discloses the method of claim 46, wherein the search queries have associated demographic information and the filtering criteria include demographic criteria, the filtering including identifying queries having demographic information matching the demographic criteria (0045, 0047, country, language, etc.).

Claim 52: Speiser further discloses the method of claim 51, wherein the viewers have viewer demographics, the method further comprising selecting demographic criteria to match viewer demographics, the filtering including identifying queries having demographic information matching the viewer demographics, thereby initiating display of filtered search queries relevant to the viewers (0085; 0047).

Claim 53: Speiser further discloses the method of claim 46, wherein the filtering criteria include search queries previously entered by users and the filtering includes discarding previously entered search queries (0058, the Examiner understands terms matching the filter words to be discarded when they are prevented from being displayed and the determination moves to consider other terms).

Claim 54: Speiser further discloses the method of claim 46, wherein the filtering criteria include a number of times a search query is presented (0047; Fig. 4C, item 94).

Claim 55: Speiser further discloses the method of claim 54, wherein the filtering criteria **identifies relatively popular queries** from the number of times a search query is presented (0047; Fig. 4C, item 94).

Claim 56: Speiser further discloses the method of claim 55, wherein initiating the display includes initiating display of filtered search queries to viewers at an event (0085, Figs. 12A and B; the Examiner understands an event to be something that takes place, or an occurrence, such as searching, shopping, or bidding at an auction website).

Claim 57: Speiser further discloses the method of claim 54, wherein the filtering criteria include a certain website and a number of times a search query is presented,

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the filtering including **identifying relatively popular search results** received via the certain website (0047; Fig. 4C, items 94 and 96; and 0040, 0047, where the Site ID identifies the certain website).

Claim 58: Speiser further discloses the method of claim 54, wherein the filtering criteria include demographic criteria and a number of times a search query is presented, the filtering including **identifying relatively popular search queries** received from users having demographics matching the demographic criteria (0047; Fig. 4C, items 94 and 96).

Claim 59: Speiser discloses the method of claim 46, but does not explicitly disclose wherein initiating the display includes incorporating the search queries into a Flash movie clip. Speiser, however, discloses listing the popular search queries (0085-0086, Figs. 12A and B). The Examiner understands that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Speiser in order to initiate a Flash movie via the advertisement.

The rationale for combining in this manner is that a Flash movie is one of a limited number of predictable options available for forms of advertisements.

Claim 60: Speiser further discloses the method of claim 46, wherein the scrolling ticker of search queries includes one or more links associated with one or more search queries, respectively, wherein each link is to search results corresponding to the associated search query (0085-0086, Figs. 12A and B).

Claim 61: Speiser further discloses the method of claim 46, wherein initiating display of the advertisement includes initiating inclusion of a search window for receiving a new search query in the advertisement (Fig. 12A, top left corner).

9. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, it meets the claim. See *e.g. In re Collier*, 158 USPQ 266, 267 (CCPA 1968) (where the court interpreted the claimed phrase “a connector member for engaging shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements” and where the court interpreted the claimed phrase “said ferrule-forming member being crimpable onto said shield means” and held that the shield means was not a positive element of the claim since “[t]here is no positive inclusion of ‘shield means’ in what is apparently intended to be a claim to structure consisting of a combination of elements.... “[t]he ferrule or connector

member is crimpable but not required, structurally, to be crimped These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefore be relied on to distinguish from the prior art.”).

The Examiner has analyzed the claim language and phrasing as indicated by the **bold** sections or words above, and determined that the phrasing following the **bolded** word(s) is not required due to the terminology being optional or intended use or expected results, in conformity with MPEP § 2111.04.

Response to Arguments

10. Applicant's arguments filed March 22, 2010 have been fully considered but they are not persuasive.

Applicant first argues that Speiser does not filter according to demographic information; however, the Examiner notes that Speiser tracks term popularity or usage, as well as demographics in the form of a Site ID identified by specific criterion such as country or language (0045, 0047, Figs. 4A-C). Fig. 5 illustrates the full method, where, for example, the data indicated at Fig. 4B is used (Fig. 5, step 102) to filter (step 104, using the searches attempted data of Fig. 4B as an example) and arrive at popular search phrases being filtered to a Preliminary Popular Search Term table and stored in a Filtered Popular Search Term table (Fig. 5, step 112, and 0054). Although the terms may be filtered using other criteria also, as indicated at

0056, the Examiner understands thus Speiser to filter according to demographics as indicated; therefore the Examiner is not persuaded by Applicant's arguments.

Applicant next argues, in relation to claim 21, that Speiser does not teach input via an on-line application and selecting user input for display to users. Although this is a spurious argument since no reasoning is present - merely the claim that the element is not taught by Speiser and therefore allowable - the Examiner offers the following in an effort to further prosecution. The Examiner notes Applicant's claim phrasing and breadth:

- receiving user input only requires that a user input something, such as search terms, into the system (as indicated at 0027), and the system of Speiser is a network-based commerce system (0032), therefore on-line.
- selecting for display based on filtering criteria would only require that the entered search terms be selected for display – the filter criteria at claim 21 need be no more than, for example, that the user entered the terms – so the breadth of phrasing indicates only that a users search terms be displayed to them; however, Speiser indicates filtering by "bad" words (0056) and displaying to other users also (0044, Figs. 12A-B, item 196, "popular searches").
- facilitating display does not require actual display, only facilitation or help towards display, however, actual display indicates that facilitating the display has occurred, therefore, displaying search terms back to a user would be

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adequate; however, Speiser indicates the display to others as well (0044, Figs. 12A-B, item 196, "popular searches"). The Examiner notes that the receiving step indicates multiple users input (as Speiser indicates users at 0027), and the facilitating display step is to users, the claim breadth, as indicated above, is that displaying a user's search terms back to the user upon entry is all that is required.

Therefore, since all elements are clearly indicated by Speiser, the Examiner is not persuaded by Applicant's argument.

Applicant's final argument, in relation to claim 62, is that Speiser does not disclose an advertisement with a portion for advertisement content and a portion for displaying search queries. First, the Examiner notes that claim 62 is drawn to an advertisement, and as such, it is not considered patentable subject matter – the claim encompasses printed materials that may be placed on a billboard or a bulletin board, for example; therefore, the elements that comprise or differentiate such unpatentable subject matter may be granted little if any patentable weight. Second, the Examiner notes that the links listed in Fig. 12A, for example, are each an advertisement: they are each, on their own, enticing the user to buy that item – some by listing technical specs, others by pricing, others by offering terms such as "No Reserve" – they are each also advertising, through the use of a link, the presence of more information, hopefully, regarding that particular item. Furthermore, the entire page is an advertisement encouraging the user to investigate, use, or explore the

web site - and it is noted that Popular Searches (at item 196 and Fig. 12B) are displayed, and filtered according to the reasoning indicated in response to the above arguments. Therefore, the Examiner is not persuaded by Applicant's argument.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT D. GARTLAND whose telephone number is 571-270-5501. The examiner can normally be reached on 7:30-6:00 EST Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number

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for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. D. G./
Examiner, Art Unit 3622

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622